

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action, dated July 26, 2005, in which: claims 1-16 and 28-36 stand rejected under 35 USC 102 on US Patent No. 6,339,767 (hereinafter, "Rivette"). Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-16 and 28-36 are pending. Claims 17-27 and 37-41 have been withdrawn in response to a restriction requirement from the Examiner. It is noted that no prosecution history estoppel necessarily results because Assignee retains the right to pursue these claims in a separate patent application.

As noted above, the Examiner has rejected claims 1-16 and 37-41 as unpatentable under 35 U.S.C. § 102 in view of Rivette. These rejections by the Examiner are respectfully traversed.

As is well-known, to establish a *prima facie* case of unpatentability under 35 U.S.C. § 102, the Examiner must establish that each and every element and limitation of the rejected claim is taught by the cited document. Assignee asserts that here the Examiner has failed to make the necessary showing.

With respect to the merits of the specific claim rejections, we begin by discussing claim 1. Here, the Examiner has failed to establish, for example, that the cited document satisfies the recited language of claim 1 directed to generating a search query.

For example, in discussing the cited document, the Examiner states, on page 5 of the office action: "A user may search for a particular patent using a searching module." Thus, as this comment makes clear, in Rivette, the user generates the search query, which is not what is recited in claim 1 above. Again, the Examiner implicitly acknowledges this deficiency of Rivette by also stating on page

5 of the office action: "...a user provided search query identifies/generates a first set of one or more data elements... ."

In contrast, claim 1 recites: "generating a search query... ." Furthermore, while claimed subject matter is not limited to embodiments described in the specification; nonetheless, discussion of an embodiment from the specification may prove instructive in this context. For example, in one particular embodiment, a search query is generated through application of various techniques to parse information provided by the user, for example. This is discussed, for example, on page 7 of the specification. Again, this is merely an example embodiment and does not limit the scope of the claims. However, it does assist in illustrating that Rivette has no discussion of generating a search query as claimed, or even described, in the above-referenced patent application. It is, therefore, respectfully requested that the Examiner withdraw this rejection of claim 1 on these grounds.

The remaining rejected claims patentably distinguishable from Rivette at least on the same or a similar basis as claim 1. Thus, it is also requested that the Examiner withdraw the rejection of these remaining claims on this ground as well.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,



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